

## **REMARKS**

In the outstanding Office Action (the "Office Action"), mailed January 25, 2006, the Examiner objected to the specification; rejected claim 27 under 35 U.S.C. § 102(b) in view of U.S. Patent No. 6,021,336 to Kunihiro et al. (hereinafter, "Kunihiro"); rejected claims 28, 30-31, and 34-35 under 35 U.S.C. § 103(a) as being unpatentable over Kunihiro; rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Kunihiro in view of Japanese Patent Publication No. 04-085650 to Kizawa (hereinafter, "Kizawa"); and rejected claims 32-33 under 35 U.S.C. § 103(a) as being unpatentable over Kunihiro in view of Japanese Patent Publication No. 01-137362 to Okayama et al. (hereinafter, "Okayama").<sup>1</sup>

By this amendment, Applicants have canceled claim 30 and withdrawn claims 36-37 without prejudice or disclaimer of their subject matter and amended claims 27 and 31-34 to improve form and to more appropriately define their invention. Support for the amendments can be found in the specification at, for example, page 21, lines 1-2 and 22-24 and Figures 5-8. No new matter has been added. Accordingly, claims 27-29 and 31-35 remain pending.

In light of the foregoing amendments and based on the arguments presented below, Applicants respectfully traverse the objection to the specification. Additionally, Applicants respectfully traverse the rejections of the claims under 35 U.S.C. §§ 102(b) 103(a) and request allowance of claims 27-29 and 31-35.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

## **I. Objection to the Specification**

The Examiner objected to the specification at page 1 stating the terms “terminate device” and “terminate devices” are “not meaningful in the context of the invention.” In addition, the Office Action objected to the specification at page 29 and the use of the phrase “display panel 305.” Applicants respectfully traverse the objection to the phrases “terminate device” and “terminate devices.” However, to advance prosecution, Applicants have amended the specification on page 1, lines 18-21 and page 2, line 2 to refer to “terminal device” and “terminal devices.” In addition, Applicants have amended the specification at page 29, line 18 to refer to “display panel 308.” No new matter has been added. In light of the foregoing amendments, Applicants respectfully request reconsideration and withdrawal of the objection to the specification.

## **II. Claim Rejections Under 35 U.S.C. 102(b)**

In the outstanding Office Action, claim 27 was rejected under 35 U.S.C. § 102(b) as being anticipated by Kunihiro. Applicants respectfully traverse this rejection. A proper anticipation rejection requires each and every element set forth in the claim be found in a single prior art reference. See MPEP § 2131. The anticipation rejection set forth in the Office Action does not properly establish that each and every claimed element is found in Kunihiro.

Kunihiro discloses a “portable communication terminal capable of transmitting text data comprising input means used for selecting the operation of said portable communication terminal and inputting letters; display means capable of displaying at least letters and a cursor; storage means for storing a plurality of specific text data; and control means for displaying text data selected from said plurality of typical pattern text

data stored in the storage means by said input means on said display means, and inserting the letters which are inputted by said input means into a predetermined position of said text data displayed to complete a transmission text data.” Kunihiro, column 1, lines 28-39. Kunihiro further discloses a “control circuit...to switch the display to a picture for selecting a fixed sentence and [wait] for user selection.” Kunihiro, column 3, lines 16-19. If the user selects “one in the picture, the control circuit...display[s] the selected fixed sentence on the screen of the LCD device.” Kunihiro, column 3, lines 19-22.

While Kunihiro discloses the display and selection of either a fixed sentence or a “plurality of fixed sentences,” Kunihiro does not teach or suggest a “group of candidate terms” nor does Kunihiro teach or suggest “candidate term displaying means for displaying...a group of candidate terms,” as in claim 27. Kunihiro, column 3, lines 59-60. That is, the plurality of fixed sentences disclosed by Kunihiro are a **single** selectable entity. Kunihiro, column 3, lines 45-65; Figures 5A-5C. They are **not** disclosed as individually selectable such that there is “candidate term displaying means for displaying...a group of candidate terms” and a “term selecting means for outputting a term selected...out of said group of candidate terms,” as in claim 27. This is evidenced by the example provided by Kunihiro in which “the user selects a fixed sentence asking for [a] telephone call [and] the picture shown in FIG. 5A is displayed.” Kunihiro, column 3, lines 62-64 and Figure 5A. While the user is given the opportunity to input “letter sequence[s],” Kunihiro does not disclose a “term selecting means for outputting a term selected by a communicator out of said group of candidate terms,” as in claim 27. Kunihiro, column 3, line 61 through column 4, line 15.

The Office Action refers to Figures 5A-5C as teaching that “said candidate terms are classified according to at least one of a set of names of said participants in the game, and a plurality of nouns, pronouns, verbs, adjectives, inflections, symbols, or user-registered short sentences” that are related to the game. Office Action at page 5. However, neither the referenced figures nor any other figure in Kunihiro supports such a statement. Kunihiro discloses a “plurality of fixed sentences” with respect to Figures 5A-5C, Kunihiro does not teach or suggest “sets of candidate terms” or “user-registered short sentences,” as in claim 27. Thus, Kunihiro cannot further teach or suggest “wherein said candidate terms are classified in said sets according to at least one of a set of names of said participants in the game, and a plurality of nouns, pronouns, verbs, adjectives, inflections, symbols, or user-registered short sentences that are related to the game,” as in claim 27. Furthermore, while Kunihiro discloses the ability to “switch the display to a picture,” as stated above, Kunihiro does not teach or suggest “categories of candidate terms” and therefore cannot further teach or suggest a “candidate category switching means for switching between sets of candidate terms,” as in claim 27. Kunihiro, column 3, lines 16-19.

In summary, Kunihiro does not teach or suggest “candidate term displaying means for displaying...a group of candidate terms,” “term selecting means for outputting a term selected...out of said group of candidate terms,” “candidate category switching means for switching between sets of candidate terms,” “wherein said sets of candidate terms include at least one group of candidate terms,” and “wherein said sets of candidate terms are classified according to at least one of a set of names of said participants in the game, and a plurality of nouns, pronouns, verbs, adjectives,

inflections, symbols, or user-registered short sentences that are related to the game,” as in claim 27.

For at least these reasons, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. 102(b) and allowance of claim 27.

### **III. Claim Rejections Under 35 U.S.C. 103(a)**

Applicants respectfully traverse the rejections under 35 U.S.C. § 103(a) because the Examiner has not established a *prima facie* case of obviousness as required under 35 U.S.C. § 103(a).

“To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

#### **A. Claims 28, 30-31, and 34-35**

The Examiner has rejected claims 28, 30-31, and 34-35 under 35 U.S.C. § 103(a) over Kunihiro. This rejection is moot with respect to claim 30 due to Applicants’ cancellation of that claim. The Examiner bases the rejections of these claims on both Kunihiro and that which is “well-known in the art.” Applicants submit that the Examiner is taking Official Notice of alleged prior art features. Applicants traverse the taking of Official Notice in the Office Action and respectfully request the Examiner to provide authority for the asserted statements.

A general allegation that something may be “well known” is not sufficient to support a taking of Official Notice. “[T]he basis for [the examiner’s] reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” See [*In re Soli*, 317 F.2d 941, 137 U.S.P.Q. 797 (CCPA 1963)], 317 F.2d at 946, 37 USPQ at 801; [*In re Chevenard*, 139 F.2d 711, 60 U.S.P.Q. 239 (CCPA 1943)], 139 F.2d at 713, 60 USPQ at 241. “The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” M.P.E.P. § 2144.03(B).

The Office Action alleges that “character communication using a game device in a game environment is well known in the art” and “it would have been obvious...in order to provide the capability of transmitting text data speedily and easily.” Office Action at page 4. However, the Office Action fails to provide any reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of Kunihiro other than general allegations such as, for example, “it would have been obvious ...in order to provide the capability of transmitting text data speedily and easily.” Office Action at page 4. Thus, the Office Action merely provides conclusory statements about the cited references, none of which are sufficient to constitute establishment of a *prima facie* case of obviousness.

In addition, that which is “well known in the art” does not, *inter alia*, cure the deficiencies set forth above, as well as the failure of Kunihiro to disclose “candidate term displaying means for displaying...a group of candidate terms,” “term selecting

means for outputting a term selected...out of said group of candidate terms,” “candidate category switching means for switching between sets of candidate terms,” “wherein said sets of candidate terms include at least one group of candidate terms,” and “wherein said sets of candidate terms are classified according to at least one of a set of names of said participants in the game, and a plurality of nouns, pronouns, verbs, adjectives, inflections, symbols, or user-registered short sentences that are related to the game,” as in claim 27.

For at least these reasons, neither Kunihiro, nor that which is well known in the art, nor the combination of the two, teach or suggest all the elements of Applicants’ independent claim 27. Therefore, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a) and request allowance of claim 27 as well as claims 28, 30, 31, 34, and 35 that depend therefrom.

#### **B. Claim 29**

The Office Action has rejected claim 29 under 35 U.S.C. § 103(a) as unpatentable over Kunihiro and Kizawa. Kizawa appears to disclose “an operation manual preparing device for equipment” that “output[s] an operation manual” to enable operators “to fully use the functions of the equipment.” See Kizawa, pages 8-9. Kizawa appears to further disclose the device as including a “data storage means for retrieving [and] storing data required for preparing an operation manual,” “language indicating means...indicat[ing] preparation of an operation manual corresponding to the languages of various countries,” and “selection means for storing selected information for selecting an operation manual.” See Kizawa, pages 8-9.

However, Kizawa does not cure the deficiencies of Kunihiro set forth above including the failure of Kunihiro to teach or suggest “candidate term displaying means for displaying...a group of candidate terms,” “term selecting means for outputting a term selected...out of said group of candidate terms,” “candidate category switching means for switching between sets of candidate terms,” “wherein said sets of candidate terms include at least one group of candidate terms,” and “wherein said sets of candidate terms are classified according to at least one of a set of names of said participants in the game, and a plurality of nouns, pronouns, verbs, adjectives, inflections, symbols, or user-registered short sentences that are related to the game,” as in claim 27.

While the Office Action, at paragraph 7, states that “Kizawa discloses an invention for receiving requested information items from other communication devices” and alleges that this cures deficiencies of Kunihiro, such is not the case. Kizawa teaches a system and method for preparing and outputting an operation manual for a piece of equipment when requested by a user. Kizawa, pages 8-9 and 15. While Kizawa teaches separate “communication processing sections FCU1 and FCUn” connected to a bus and the retrieval of data by one processing section from another processing section, Kizawa does not teach or suggest a counterparty, as recited by Applicants in claim 29. Kizawa only teaches interaction between a user and a piece of equipment. Kizawa, pages 8-9. Furthermore, Kizawa does not teach or suggest “an invention for receiving requested information items from other communication devices,” as asserted by the Office Action, because Kizawa does not disclose communication devices as such. While Kizawa does disclose a system and method for use in equipment such as a facsimile machine, the system and method of Kizawa are not



related to the use of the facsimile machine as a communication device but rather as a piece of equipment that requires an operator's manual for proper use. Office Action, paragraph 7; See Kizawa, pages 8-10.

In addition to the failure of Kunihiro and Kizawa to teach or suggest all the claim limitations, either alone or in combination, the Office Action's stated motivation for combining these references is neither suggested by the references themselves nor in the knowledge generally available to one of ordinary skill in the art. Further, Kunihiro and Kizawa disclose non-analogous inventions intended for entirely different purposes and it would not have been obvious to one of ordinary skill in the art to combine the references. The Office Action's assertion, at paragraph 7, that it "would have been obvious...to combine Kizawa's teaching with Kunihiro's in order to minimize storage requirement[s]" misrepresents the teachings of Kizawa. Kizawa discloses the "required capacity of the storage section in which the...data is stored is curtailed" by "translat[ing] into the indicated language" an operation manual "when there is an indication of the type of language." That is, Kizawa discloses an operation manual that is not stored in a large number of languages but rather translated upon user request. Thus, by not storing a large number of translated operation manuals, Kizawa is able to reduce the storage requirements. Such a schema would not be subject to combination with the system and method of Kunihiro and it is unclear how a motivation to combine the two very divergent disclosures can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Therefore, it would not have been obvious to use the storage reduction scheme taught by Kizawa in the system and method disclosed by Kunihiro.

For at least the reasons stated above, Applicants submit that neither Kunihiro, nor Kizawa, nor the combination of the two teach or suggest all the elements of Applicants' claim 29 nor is there any motivation to combine the references. Thus, Applicants respectfully request allowance of claim 29.

### **C. Claims 32-33**

The Office Action has rejected claims 32 and 33 under 35 U.S.C. § 103(a) as unpatentable over Kunihiro and Okayama. Okayama appears to disclose "a medical coding system" that allows "the course of medical treatment of each patient [to be] input by codes from an accounting terminal." Okayama, page 4. Okayama further discloses a "file [for] storing input item codes that correspond to set codes, which are obtained by grouping multiple input items into sets." Okayama, page 3. In other words, Okayama discloses that "when a certain medical treatment is known to include multiple treatment actions in advance, these are registered as a set and are input by using a set code" in order to "allow...reductions in manual inputting labor and inputting time by using such sets of medical care contents." Okayama, page 4.

Okayama does not cure the deficiencies of Kunihiro set forth above and the failure of Kunihiro to teach or suggest "candidate term displaying means for displaying...a group of candidate terms," "term selecting means for outputting a term selected...out of said group of candidate terms," "candidate category switching means for switching between sets of candidate terms," "wherein said set of candidate terms include at least one group of candidate terms," and "wherein said sets of candidate terms are classified according to at least one of a set of names of said participants in the game, and a plurality of nouns, pronouns, verbs, adjectives, inflections, symbols, or

user-registered short sentences that are related to the game,” “candidate category switching means for switching between sets of candidate terms,” as in claim 27.

In addition, the Office Action asserts that “[c]laim 32 is similar in scope to claim 31, and would be therefore rejected under similar rationale;” however, the Office Action does not provide any basis upon which this rejection is made. Office Action, page 6. Specifically, neither claim 31 nor any of the claims from which it depends recites “storing means for storing a database including a plurality of messages in a single language and a mark added to one or more of said plurality of message; a menu displaying device for selectably displaying some of said plurality of messages on a menu screen of said screen display; message mark outputting means for outputting the mark corresponding to a selected message by referring to said database; and transmitting means for transmitting the outputted message mark to the counterparty to a communication,” as in claim 32. Further, the Office Action clearly states that “Kunihiro does not disclose the use of a mark corresponding to a selected message.” Office Action, page 6. Thus, it is unclear how Kunihiro can teach or suggest any of the limitations recited in claim 32 and it appears that the Office Action has simply neglected to address these limitations.

Additionally, the Office Action states that “Okayama teaches a database (dictionary file) having contents with corresponding input item marks, wherein based on the input items marks, corresponding information items are retrieved and displayed.” Office Action, page 6. Applicants are unclear as to how this statement and the disclosure of Okayama relate to the limitations found in claim 32. It appears that the “input item marks” referenced in the Office Action are referring to the “input item codes” found in Okayama. Office Action, page 6; Okayama, page 3. These “input item

codes...**correspond to** set codes, which are obtained by grouping multiple input items into sets.” Okayama, page 3 (emphasis added). However, Applicants’ claim 32 recites “storing means for storing a database including a plurality of messages in a single language and a **mark added to** one or more of said plurality of messages” (emphasis added). Applicants’ claim 32 further recites “message mark outputting means for outputting the mark corresponding to a selected message by referring to said database; and transmitting means for transmitting the outputted message mark to the counterparty of a communication.” Okayama does not teach or suggest, nor does the Office Action infer that Okayama teaches or suggests, “message mark outputting means” and “transmitting means,” as in claim 32.

In addition to the failure of Kunihiro and Okayama to teach or suggest all the claim limitations, either alone or in combination, the Office Action’s stated motivation is neither suggested by the references themselves nor in the knowledge generally available to one of ordinary skill in the art. Further, Kunihiro and Okayama disclose non-analogous inventions intended for entirely different purposes and it would not have been obvious to one of ordinary skill in the art to combine the references. The Office Action’s assertion, at paragraph 8, that it “would have been obvious...to combine Okayama’s teaching with Kunihiro’s in order to provide a short-cut and quick means for entering lengthy information” fails to provide a reason to combine the teachings of Okayama with Kunihiro at least because the suggested motivation is not a motivation to combine but rather a desired result and, in the proposed combination, would not result in the limitations of Applicants’ claim 32. As stated above, in Okayama, the “input item codes...**correspond to** set codes, which are obtained by grouping multiple input items

into sets;" whereas, Applicants' claim 32 recites "storing means for storing a database including a plurality of messages in a single language and a **mark added to** one or more of said plurality of message." Okayama, page 3 (emphasis added). Thus, combining Okayama with Kunihiro would not result in the recitations found in claim 32 including "storing means for storing a database including a plurality of messages in a single language and a mark added to one or more of said plurality of message; a menu displaying device for selectably displaying some of said plurality of messages on a menu screen of said screen display; message mark outputting means for outputting the mark corresponding to a selected message by referring to said database; and transmitting means for transmitting the outputted message mark to the counterparty to a communication," as in claim 32.

For at least these reasons, Applicants submit that neither Kunihiro, nor Okayama, nor the combination of the two teach or suggest all the elements of Applicants claims. Thus, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a) and request allowance of claims 32-33.

#### **IV. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

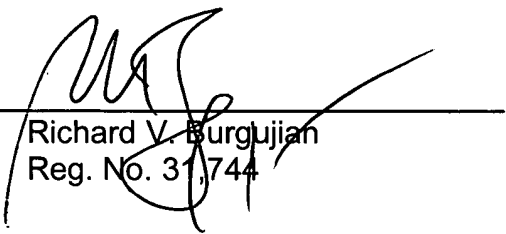
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 15, 2006

By: \_\_\_\_\_

  
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